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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77505597
Applicant	DRHORSEPOWER, INC.
Applied for Mark	DRHORSEPOWER YOUR PRESCRIPTION FOR WINNING!
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Serial No. 77/505597

Mark: DRHORSEPOWER YOUR PRESCRIPTION FOR WINNING! (&
Design)

Applicant: DRHORSEPOWER, INC.

Examining Attorney: Anne Gustason
Law Office 117

EX PARTE APPEAL

APPLICANT'S BRIEF

COMES NOW the Applicant, DrHorsepower, Inc. by Counsel, and hereby respectfully appeals the Examining Attorney's refusal to register the mark DRHORSEPOWER YOUR PRESCRIPTION FOR WINNING! (& Design):



Applicant seeks to register the mark in International Class 32 for Non-alcoholic beverages, namely, energy drinks. The Examining Attorney refused registration under Section 2(d), stating the mark is likely to cause confusion between Applicant's mark and HORSEPOWER ENERGY DRINKS standard word mark, U.S. Reg. No. 3/690,631, currently registered for International Class 32, for Beverage Drinks, Namely, Energy Drinks.

I. DESCRIPTION OF THE RECORD

Registration is sought for DRHORSEPOWER YOUR PRESCRIPTION FOR WINNING! (& Design) in International Class 32 for Non-alcoholic beverages, namely, energy drinks:



The Examining Attorney initially issued an Office Action finding there to be a likelihood of confusion predominantly because of the similarity of the marks and the relationship of the goods. Applicant submitted its Response to Office Action, arguing that confusion was not likely and submitting evidence that “horsepower” was a commonly used phrase, a crowded phrase, for the relevant goods. After an additional final office action, the ultimate result was that in light of a third party cancellation proceeding and Applicant’s cancellation proceeding against the cited registration, this Appeal and further proceedings on Applicant’s Application were suspended.

In pertinent part, Applicant’s cancellation proceedings asserted that regardless of likely confusion the cited mark was registered on the basis of an intent-to-use application that had been applied-for without a bona fide intent to use. This proceeding was ultimately dismissed solely on procedural grounds without any substantive decision. Hence these proceedings were resumed, and this Brief is timely filed.

II. ISSUES ON APPEAL

The issue presented in this appeal is whether a refusal on the basis of Section 2(d) is error, because the applied for mark DRHORSEPOWER YOUR PRESCRIPTION FOR WINNING! (& Design) is not likely to cause confusion with U.S. Registration No. 3/690,631, in the applied-for Class 32 goods.

III. RECITATION OF THE FACTS

The applied-for mark is DRHORSEPOWER YOUR PRESCRIPTION FOR WINNING! (& Design) in International Class 32 for Non-alcoholic beverages, namely, energy drinks:



The cited mark forming the basis of the Examining Attorney's Section 2(d) refusal is HORSEPOWER ENERGY DRINKS standard word mark, U.S. Reg. No. 3/690,631, currently registered for Beverage Drinks, Namely, Energy Drinks.

In addition to these facts, Applicant submitted evidence that the term "horsepower" was both a descriptive term and a term commonly used when it comes to energy drinks, the relevant goods at issue. *See* April 13, 2011 Response to Office Action. The Examining Attorney has submitted with the Office Actions evidence that energy drinks are related.

Against this backdrop, and for the reasons analyzed below, the Board should reach the firm conclusion that the Section 2(d) refusal should be reversed.

IV. ARGUMENT

A likelihood of confusion may be found only where: (1) an applicant's mark is similar to the cited registered mark in terms of appearance, sound or commercial impression, and (2) the applicant's goods and/or services are so related to those of the registrant, or the activities surrounding their marketing are such, that confusion as to the origin of the parties' goods and/or services is likely to occur in commerce. *In re E.I. Dupont de Nemours & Co.*, 177 USPQ 563

(CCPA1973); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Further:

In testing for likelihood of confusion . . . the following, when of record, must be considered: (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound connotation and commercial impression. (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use. (3) The similarity or dissimilarity of established, likely-to-continue trade channels. (4) The conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing. (5) The fame of the prior mark (sales, advertising, length of use). (6) The number and nature of similar marks in use on similar goods. (7) The nature and extent of any actual confusion. (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion. (9) The variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark). (10) The market interface between applicant and the owner of a prior mark. . . . (11) The extent to which applicant has a right to exclude others from use of its mark on its goods. (12) The extent of potential confusion, i.e., whether de minimis or substantial. (13) Any other established fact probative of the effect of use.

In re E. I. Du Pont de Nemours & Co., 476 F.2d 1357, 1361 (CCPA 1973). Certain factors will be more significant than others in given cases, and generally factors not supported by evidence or argument need not be considered in the analysis. *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336 (Fed. Cir. 2001).

However, it is important to keep in mind that possible similarities in marks or relatedness of goods are not automatically sufficient to show likely confusion, and often the end result of a careful analysis is that a likelihood of confusion is found lacking. As one court noted:

“McCarthy's on Trademarks is replete with examples of similar or identical trademarks for related goods found to be non-infringing.” *Renaissance Greeting Cards, Inc. v. Dollar Tree Stores, Inc.*, 405 F. Supp. 2d 680, 695 (E.D. Va. 2005) citing McCarthy on Trademarks § 24:62 in turn citing *Allstate Ins. Co. v. Allstate Inv. Corp.*, 210 F.Supp. 25, 28 (W.D.La. 1962) (No

infringement between plaintiff's use of ALLSTATE mark in insurance industry and defendant's use in mortgage brokerage); *American Optical Corp. v. American Olean Tile Co.*, 185 U.S.P.Q. 405, 409-10 (S.D.N.Y. 1974) (no infringement of plaintiff's mark of AO for anti-skid floor coating by defendant's use of AO for ceramic tile products); *IDV North America, Inc. v. S & M Brands, Inc.*, 26 F. Supp. 2d 815, 824 (E.D.Va. 1998) (BAILEY's low priced cigarettes are not an infringement of BAILEY's liqueurs such as BAILEY's IRISH CREAM); *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 966 (2d Cir. 1981) (No infringement of plaintiff's mark for BRAVOS used on crackers by defendant's use of BRAVOS on tortilla chips despite virtually identical marks and close relation of products); *Edison Bros. Stores, Inc. v. Cosmair, Inc.*, 651 F.Supp. 1547, 1562-63 (S.D.N.Y. 1987) (defendant's use of NOTORIOUS mark for its perfume does not infringe plaintiff's mark of NOTORIOUS used for women's clothing and shoes); *Riva Boats Int'l S.p.a. v. Yamaha Motor Corp.*, 223 U.S.P.Q. 183 (C.D.Cal. 1983) (defendant's use of RIVA on motor scooters does not infringe plaintiff's right to use RIVA mark on luxury boats because plaintiff's mark is weak); *Knaack Mfg. Co. v. Rally Accessories, Inc.*, 955 F.Supp. 991, 1004 (plaintiff's WEATHERGUARD mark used in line of tool boxes and truck and van equipment not infringed by defendant's use of WEATHERGUARD mark for semi-fitted car covers).

Here, the most important considerations are: (1) similarity and dissimilarity of the marks (and their respective strengths), (2) channels of trade, (3) the number and nature of similar marks in use on similar goods, (4) the extent to which applicant has a right to exclude others from use of its mark on its goods, and (5) the extent of potential confusion, i.e., whether de minimis or substantial. Full consideration of the important factors demonstrates that a Section 2(d) does not support a refusal on the basis of likely confusion.

The Marks Differ in Appearance, Meaning, Sound and Commercial Impression

In the present instance, however, confusion is unlikely to occur between the applicant's mark and the cited registered mark because they differ significantly in appearance and sound, and other considerations, and as a result convey entirely different commercial impressions, when properly considered in their entirety. The marks properly viewed and without improper (over-dissection) have entirely different commercial impressions. This goes so far beyond the mere addition of terms since "there are recognizable differences between the assertedly conflicting product marks." *In re Champion Oil Co.*, 1 U.S.P.Q.2d 1920, 1921 (TTAB 1986).

For purposes of likelihood of confusion, marks must be viewed in their entireties and not dissected into individual component parts and analyzed piecemeal. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *In re Bed and Breakfast Registry*, 229 USPQ 818, 819 (Fed. Cir. 1986). The commercial impression of a mark is derived from the mark as a whole, not from its elements separated and considered in detail. *Estate of P.D. Beckwith, Inc., v. Commissioner of Patents*, 252 U.S. 538, 545-56 (1920); *Sleeper Lounge Co., v. Bell Mfg. Co.*, 253 F.2d 720, 117 USPQ 117 (9th Cir. 1958).

The Examining Attorney opined that the applicant's mark DR. HORSEPOWER YOUR PRESCRIPTION FOR WINNING & DESIGN is confusingly similar to the registered mark HORSEPOWER ENERGY DRINKS because it contains the word HORSEPOWER. However, the Examining Attorney's analysis of the marks is significantly flawed because the Examining Attorney erroneously dissected the applicant's mark and ignored several highly distinctive elements in the applicant's mark to reach the faulty conclusion that it is confusingly similar to the cited registered mark. The literal portion of the applicant's mark is not simply HORSEPOWER as the examining attorney suggests, but rather it is the unique name DR.

HORSEPOWER and the slogan YOUR PRESCRIPTION FOR WINNING (with “prescription” underlined to ensure maximum emphasis in the minds of consumers).

The applicant’s mark also consists of a fanciful design of a whiskered doctor riding on a cartoon dragster with smoke emanating from the wheels. Conversely, the cited registered mark is comprised only of the term HORSEPOWER and the generic wording ENERGY DRINKS (which were disclaimed by the cited registration). This design feature is not off to the side, but instead is the most prominent, largest, and front-and-center element of the entire mark, around which the entire remainder of the mark is constructed:



Whatever instances in which a design element might be minimized in consumer minds, this is not one of those situations, and instead such arbitrary design element is entitled to substantial weight in assessing the overall effect of the similarities and dissimilarities of the marks. *Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 U.S.P.Q.2D (BNA) 1825 (TTAB 2013) (arbitrary portion of mark is entitled to more weight than highly suggestive common elements) citing *Pioneer Hi-Bred Corn Co. v. Welp*, 280 F.2d 151, 47 C.C.P.A. 1118, 1960 Dec. Comm'r Pat. 456, 126 USPQ 398 (CCPA 1960); *In re Nev. State Bank*, 2007 TTAB LEXIS 500 (TTAB Sept. 26, 2007, Unpublished Serial No. 76487874) (“While the term REDI is highly suggestive,

the character design in registrant's mark is entirely arbitrary and unique, and is most significant in conveying the commercial impression of registrant's mark. Giving more weight to the stronger design feature, we find that the marks, as a whole, create distinctly different commercial impressions.”). And this is not the type of design element that can be discounted simply because the comparison is against an unstylized word mark – this goes far beyond stylization to a highly distinct image (one the cited registrant doesn’t and couldn’t use with its mark without engaging in copyright infringement). Thus, this distinguishing matter evidences a lack of likely confusion as to these six stylized marks as well.

In addition to looking entirely different, the applicant’s mark does not sound like or convey the same commercial message as the cited registered mark. The applicant’s mark has (6) six words and 12 syllables and is phonetically substantive. The applicant’s mark conveys the message that its beverages are “just what the doctor ordered,” adding substantially emphasize the combined “Dr. Horsepower” to immediately create this allusion and distinct image in the mind of the reasonable consumer. The use of the slogan “Your Prescription for Winning” in the mark makes this unreasonable to miss and unlikely to be ascribed the same meaning or impression as “Horespower” alone followed by “Energy Drinks.” *Cf. Safe-T Pacific Co. v. Nabisco, Co.*, 204 USPQ 307, 315-317 (TTAB 1979) (alliterative feature a significant difference).

The consumer is impressed with the feeling that only the best and healthiest of ingredients, they will help consumers perform their absolute best and win races in life, similar to a race car needing the best parts to be number one crossing the finish line. Conversely, the cited registered mark only has 3 words and 7 syllables, and as a result, is much shorter in sound than the applicant’s mark.

The cited registered mark also conveys an additionally different message than the applicant's mark, namely, that the registrant's product is a powerful energy drink.

Accordingly, when the parties' marks are properly viewed, they do not sound alike or convey the same commercial impression and these differences obviate any likelihood of confusion between them.

By dissecting the applicant's mark into pieces and ascribing "horsepower" blinding weight, the Examining Attorney has not appropriately weighed the visual and phonetic and aspects and differences between the marks and their different impressions to consumers - differences which would enable the applicant's mark and the cited registered mark to peacefully co-exist on the Register and in commerce – which they have been doing for some time. Since the respective marks are quite distinguishable in appearance and sound and convey entirely different commercial impressions, their contemporaneous use will not cause confusion in the marketplace, as numerous similar decisions of this Board and Courts across the U.S. have repeatedly found. *See above*.

Accordingly, the refusal under Trademark Act Section 2(d) is unwarranted and should be withdrawn so the applicant's mark may proceed to publication.

The Parties Goods Travel in Different Channels of Trade

Another key consideration in a likelihood of confusion analysis is whether the parties' goods and/or services travel in the same channel of trade. It is well established that when parties' goods and/or services are sold to different classes of consumers through different channels of trade, a likelihood of confusion is reduced. *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 21 USPQ 1388 (Fed. Cir. 1992) (holding that confusion is not likely to occur between E.D.S. for computer services and EDS for batteries and power supplies,

where both parties sell in the medical field); *In re Albert Trostel & Sons Co.*, 29 USPQ 2d 1783 (TTAB 1993)(no likelihood of confusion between PHOENIX for bulk leather sold to manufacturers of finished leather goods and PHOENIX for leather luggage sold to consumers due to differences in trade channels and purchasers); *In re Shipp*, 4 USPQ2d 1174 (TTAB 1987) (holding that confusion is not likely to occur between PURITAN for dry cleaning machine filters sold to professionals and PURITAN for dry cleaning services sold to the public.)

Confusion is unlikely to occur between the applicant's mark and the cited registered mark because the goods offered under them travel in entirely different channels of trade. The registrant's web site, located at www.horsepowerenergyonline.com, indicates that its energy drinks are available for sale via the applicant's web site and in trade channels associated with the game of golf. In fact, the home page of the registrant's web site indicates that its energy drinks or "shots" provide "18 hole energy" and are sold with a free ball marker. *See* First Response to Office Action. Consequently, based on this evidence, it is fair to say that the registrant's energy drinks are sold at establishments frequented by golfers, such as at country club golf pro shops and driving ranges. Conversely, the applicant's energy drinks are sold at convenience stores, grocery stores, gas stations, and nightclubs and bars – entirely different trade channels than the registrant's retail outlets. Accordingly, since the parties' goods travel in completely different channels of trade, the same consumer groups will not encounter them in the marketplace and become confused as to their source.

**Several Beverage Companies Use the Word HORSEPOWER
to Market Energy Drinks**

It is axiomatic to trademark law that a variety of factors must be considered in any likelihood of confusion analysis. *In re E.I. Dupont de Nemours & Co.*, 177 USPQ 563

(CCPA1973). The weight to be accorded similarities is greatly diminished where the similarities pertain to terms which are common or weak in the relevant marketplace.

“Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field.” *In re Broadway Chicken, Inc.*, 38 U.S.P.Q.2d 1559, 1565-56 (T.T.A.B. 1996). Such crowding is strong evidence “that customers are accustomed to distinguishing between different [] marks [containing such identical term], ***even on the basis of small differences.***” *General Mills, Inc. v. Health Valley Foods*, 24 U.S.P.Q.2d 1270 (T.T.A.B. 1992) (emphasis added); *In re Champion Oil Co.*, 1 U.S.P.Q.2d 1920, 1921 (TTAB 1986) (“Exceptions [to the rule of mere addition of terms] exist where (i) there are recognizable differences between the assertedly conflicting product marks or (ii) the alleged product marks are highly suggestive, merely descriptive, or play upon commonly used or registered terms.”).

A search of the Office’s online database reveals that The Coca-Cola Company applied to register the mark HUMAN HORSEPOWER for energy drinks on March 16, 2010, after the applicant applied to register the proposed mark, and that the Office published the mark on April 5, 2011. See the attached TESS record. Since the Office has determined that a likelihood of confusion does not exist with the cited registered mark and the mark in The Coca-Cola Company’s application, both of which share the word HORSEPOWER and are for energy drinks, the examining attorney should act consistently with Office practice and approve the Applicant’s mark for publication.

In addition to The Coca-Cola Company, several other parties are using the term HORSEPOWER to refer to their energy drinks. For instance, DC Brands International describes

its energy drink as “Liquid Horsepower” on its product packaging and Diesel Beverage Company advertises that its energy drink has 6000 or 9000 “horsepower” on its can. Also, NOS’ Energy Drink claims to have provided “horsepower” since 2004 and describes its energy drink as “human horsepower.” *See* Evidence Attached to First Response to Office Action.

This evidence indicates that consumers are accustomed to seeing the word HORSEPOWER used in connection with energy drinks and, as a result, will look to other elements in marks as a means of distinguishing the source of energy drinks. *See In re Broadway Chicken, Inc.*, 38 USPQ 2d 1554, 1565-66 (TTAB1996), wherein the TTAB held that “evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to other elements of the marks as a means of distinguishing the source of goods or service in the field.” *See also In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445 (TTAB 1986) *Fortunoff Silver Sales, Inc. V. Norman Press, Inc.*, 225 USPQ 863 (TTAB 1985) and *EZ Loader Boat Trailers, Inc., v. Cox Trailers, Inc.*, 213 USPQ 597 (TTAB 1982), *aff’d*, 706 F.2d 1213, 217 USPQ 986 (Fed. Cir. 1983).

Accordingly, although the applicant’s mark and the cited registered mark share the term “HORSEPOWER,” consumers, upon encountering the marks in commerce, will not mistakenly believe that the applicant’s energy drinks are produced by the registrant or that the registrant’s energy drinks emanate from the applicant. Consumers do not see “horsepower” as being associated or affiliated with only a single source for the relevant goods such that the applied-for mark and the cited registered mark would be confused with each other by merely containing such term. Instead, given the applicant’s reputation as leading provider of high energy performance

drinks, and many other highly reputable energy drink companies with evidence of record also using the term for their energy drinks, consumers who encounter the applicant's mark in commerce are even less likely to confuse the two marks.

**Extent of the Right to Exclude and The Extent of Potential Confusion, i.e., Whether
De Minimis or Substantial**

In the final analysis, the strength of the cited registered mark and the de minimis nature of any potential confusion confirm that these marks are simply not likely to be confused.

While that are merely composites of weak or generic terms are entitled to some protection, such as the cited mark's "horsepower" and "energy drink," the right to exclude for such weak marks is limited with less space to protect than a stronger mark. The rationale is simple – the stronger a mark, the more likely consumers are to ascribe weight to any similarities shared with it. As a result, the weakness of the cited registered mark must be given weight and recognized as working against likely confusion.

At the same time, given all the differences, the crowded market, the strength of the mark, and differing channels (resulting in peaceful coexistence for years), the end analysis shows that to the extent any confusion were possible, it is merely *de minimis* and does not rise to a sufficient probability of confusion so as to justify depriving Applicant of a registration under Section 2(d).

Conclusion

When properly viewed as a whole, the applicant's mark and the cited registered mark are distinguishable in appearance and sound and convey entirely different commercial impressions. These differences, coupled with the fact that the parties' goods do not travel in the same retail channels and that consumers are accustomed to seeing the term "HORSEPOWER" used in connection with energy drinks, along with the weakness of the cited registered mark and slight

chance of confusion, eliminate any *likelihood* of confusion between the marks. Accordingly, for all the foregoing reasons, the Section 2(d) refusal should be withdrawn and the applicant respectfully requests that the examining attorney approve the application for publication.

Dated this 24th Day of July, 2015.

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